

REMARKS

Claim Amendments

Independent claims 1 and 8 are hereby amended to more clearly define the personalization feature of the invention based on user priorities, to address the Examiner's objection under 35 USC 112 and to better define the invention's presentation of documents.

Dependent claims 6, 7, 11, 13 and 14 are hereby amendment to conform with the aforesaid amendments to the independent claims and/or to improve wording.

New claims 15 and 16 have been added in view of the aforesaid amendments to the independent claims.

Applicant respectfully requests reconsideration and withdrawal of the claim rejections by the Examiner having regard to the following submissions.

35 U.S.C. §112 Rejection

The Examiner rejected the prior pending claims on the basis that the wording "concepts/themes" and "sub-concepts/sub-themes" is considered to define alternative limitations which are considered improper and indefinite. In response, the applicant has amended the claims to eliminate this wording and to, instead, refers to each item viz. concepts, themes, sub-concepts and/or sub-themes, in definite terms. It is submitted that the amended claim wording complies with the requirements of 35 U.S.C. 112 and overcomes this ground of rejections.

35 U.S.C. §102 Rejection

The Examiner has rejected claims 1, 4-5, 8 and 11-12 under 35 U.S.C. §102(a) as being allegedly anticipated by Wical (U.S. Patent No. 6,460,034). In order for this rejection to be valid, the cited reference must teach every aspect of the claimed invention either explicitly or impliedly and any feature not directly taught must be inherently present. However, as detailed below, it clearly does not do so with respect to the amended claims herein and, therefore, the Examiner is requested to withdraw this ground of rejection.

The document search and retrieval system of the cited reference to Wical processes queries which are input to it. It is apparent from the Examiner's comments, contained in the

Office Action of 24 February, 2005, that the feature “according to a user’s priorities” recited in the applicant’s former claim 1(b) is being interpreted, by the Examiner, as being equivalent to Wical’s input search query (e.g. the query “Internet” in respect of Figure 10A). To the contrary, however, Wical’s input query is not - and cannot be - a “user’s priority” as in the applicant’s system but, rather, is only a “user’s selection” of a word to be searched by the system. Wical’s system generically processes any query input to the system such that the same processing and results occur for each and every user who inputs that query to the system. As such, the user is invisible to (has no effect on) Wical’s system; unlike the applicant’s system, no priority personal to any particular user is utilized or contemplated by Wical.

In view of the Examiner’s aforesaid interpretation of the recited claim feature, the applicant has amended the claims to more particularly define the recited feature, namely, the applicant’s new and unobvious user-personalized document presentation feature of the claimed electronic document viewer system which, unlike the cited prior art, prioritizes the documents according to a user’s priorities determined from preferences information personal to that user which is (i.e. pre-exists) in a user preferences knowledge base of the system.

The user-personalized presentation of the applicant’s document view system is NOT disclosed by the prior art. To the contrary, Wical’s presentation is fixed for any given user-input query and the same presentation would appear for each and every user who inputs a given query based on a given set of source documents. This is clear from Wical’s description and drawings, for example the description at Col. 3, lines 10-13 states that documents from theme groups are identified in response to a query, the theme groups are ranked based on the relevance of the theme groups to the query and the documents within the theme groups are ranked in order of relevance to the query. That is, the relevance measuring is with respect to the query (not anything personal to any particular user) and the same relevance measuring is applied for every such query irrespective of which user enters it. That is, Wical’s system applies a system ranking of documents, not a user ranking like that of the applicant’s system.

35 U.S.C. §103 Rejection

The Examiner has rejected claims 6-7 and 13-14 under 35 U.S.C. 103(a) as allegedly being unpatentable over Wical and further in view of Hyatt (U.S. patent No. 6,678,692). In order

to establish a *prima facie* case of obviousness, the Examiner must meet three requirements: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and thirdly, the prior art reference (or references when combined) must teach or suggest all the claim limitations. However, for the reasons provided above with respect to the deficient disclosure and teachings of Wical, and the submissions below, it is clear that none of these requirements are satisfied with respect to the amended claims herein. Therefore, the Examiner is requested to withdraw this ground of rejection.

Like Wical the cited reference to Hyatt does not disclose the user-personalized document presentation feature of the claimed electronic document viewer system and is not relevant to the applicant's invention. The purpose of Hyatt is to provide a system for which a user can input a concept to identify the documents sought by the user rather than search for specific text in documents in a database. For a given database of records, a predominant feature i.e. "key concept", which best characterizes each record is identified and the identified key concepts are hierarchically arranged so as to be identified by a search algorithm which searches for records relevant to that input concept. As for Wical's system, only a system ranking of documents is utilized and no user-personalization feature according to that of the applicant is disclosed.

CONCLUSIONS

For all the foregoing reasons, applicant respectfully submits that the amended/new claims 1, 4-8 and 11-16 submitted herewith are in good form for allowance and the same is requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact applicants' attorney to discuss resolution of any remaining issue.

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Respectfully submitted,



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